

## R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

## SUPPORT FOR AMENDMENT TO THE SPECIFICATION

The specification has been amended for consistency with the amendment to FIG. 2. Support for the amendments to the specification can be found in the specification as originally filed, for example, on page 1, line 14 through page 2, line 5. As such, no new matter has been added.

## IN THE DRAWINGS

FIG. 2 has been amended in light of the comment in the last two lines on page 2 of the Office Action. Support for the amendments to FIG. 2 can be found in the specification as originally filed, for example, on page 1, line 14 through page 2, line 5. Furthermore, a patent need not teach, and preferably omits, what is well known in the art (MPEP §2164.01, citing *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991)). The cited references also provide evidence that it is well known in the art for a computer to have both a mouse and a keyboard (see FIG. 1 of Bretschneider et al., U.S. Patent No. 6,128,629). As such, no new matter has been added. A replacement drawing sheet and an annotated marked-up drawing sheet are submitted herewith.

**SUPPORT FOR CLAIM AMENDMENTS**

Support for the amendments to the claims can be found (i) in the drawings as originally filed, for example, FIGS. 1-4, (ii) in the claims as originally filed, for example, claim 20 and (iii) in the specification as originally filed, for example, on page 1, line 14 through page 2, line 5, on page 3, line 13 through page 4, line 2, on page 5, line 17 through page 6, line 8, on page 13, line 17 through page 14, line 15 and in the Device Class Definition For Human Interface Device (HID), version 1.1, published April 4, 1999, which was incorporated in the specification by reference in its entirety. As such, no new matter has been added.

**CLAIM REJECTIONS UNDER 35 U.S.C. §112**

The rejection of claims 1-5, 7-17 and 19-27 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement is respectfully traversed and should be withdrawn.

One skilled in the art would consider it well known in the art that computers can have dedicated keyboard and mouse ports. The specification states:

For example, in PowerPoint advancing to the next slide is accomplished by pressing the left mouse button, or one of several keyboard keys. Inadvertently pressing the right mouse button or other keyboard keys can ruin the presentation by backing up, or worse, exiting the PowerPoint program entirely. Such an error can lead to a flurry of activity, where

the presenter often must ask a member of the support staff (or worse the audience) for assistance in resuming the presentation. Such an interruption disrupts the presentation flow and embarrasses the presenter (page 1, line 16 through page 2, line 5 of the specification).

One skilled in the art would clearly understand that a computer running a slide presentation program has a mouse and a keyboard attached and the slide presentation is controllable by both the mouse and the keyboard attached to a computer. The specification further states:

The device 100 may provide a simple control that may avoid the presentation complex options to the presenter. The device 100 may, in one example, provide one or more control signals that may control the advancing or retreating of the next slide of an electronic presentation software package. The device 100 may avoid the requirement for complex instructions that may have the potential for misuse. The device 100 may be connected to a computer (such as a PC or a Macintosh) and may operate without the necessity of pre-installing driver software. The device 100 may have the ability to "hot-plug" into the computer. **The ability to hot-plug the device 100 may enable spur-of-the-moment decisions since the device 100 may be plugged in and activated without re-booting the computer** (page 5, line 17 through page 6, line 8 of the specification).

Since the specification recites that a slide presentation is controllable by both a mouse and a keyboard and the device 100 may be plugged in with a "spur-of-the-moment" decision, the specification would reasonably convey to one of ordinary skill in the art that the device 100 could be connected to the computer "in

addition to a mouse and a keyboard," as presently claimed. As such, the rejection under 35 U.S.C. §112, first paragraph, does not appear to be proper and should be withdrawn.

**CLAIM REJECTIONS UNDER 35 U.S.C. §103**

The rejection of claims 1, 4, 5, 7-9, 12, 15-17, 19, 21-23 and 27 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider et al. '629 (hereinafter Bretschneider) in view of Sartore et al. '103 (hereinafter Sartore) is respectfully traversed and should be withdrawn.

The rejection of claims 2, 3, 10, 11 and 26 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider in view of Sartore, and in further view of Meyn et al. '623 (hereinafter Meyn) is respectfully traversed and should be withdrawn.

The rejection of claims 20 and 25 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider in view of Meyn is respectfully traversed and should be withdrawn.

The rejection of claims 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider in view of Sartore, and in further view of Vanderpool et al. '174 (hereinafter Vanderpool) is respectfully traversed and should be withdrawn.

The rejection of claim 24 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider in view of Sartore and Vanderpool, and in further view of Indekeu et al. '477 (hereinafter

Indekeu) is respectfully traversed and should be withdrawn.

Bretschneider is directed to a method and apparatus for automatically updating data files in a slide presentation program (Title). Sartore is directed to a bus interface system and method (Title). Meyn is directed to an intelligent display system presentation projection arrangement and method of using same (Title). Vanderpool is directed to a data collecting and transmitting system (Title). Indekeu is directed to a method for sizing message characters for a display (Title).

In contrast to the cited references, the presently claimed invention (claim 1) provides an apparatus comprising (a) a housing having an upper surface, (b) a first button disposed in the upper surface and configured to generate a first instruction and (c) a first device (i) disposed within the housing and (ii) configured to generate one or more first control signals in response to the first instruction, where the first control signals consist of signals dedicated to advancing through a plurality of slides presented by an electronic presentation program, where the apparatus is configured to connect, **in addition to a mouse and a keyboard**, to a second device configured to run the electronic presentation program. Claims 16 and 20 include similar limitations.

Assuming, *arguendo*, the pointing device 42 in FIG. 1 of Bretschneider is similar to the presently claimed apparatus (as

suggested in section 5 on pages 3-7 of the Office Action and for which Applicant's representative does not necessarily agree), the Office Action fails to meet the Office's burden of factually supporting any *prima facie* conclusion of obviousness (MPEP §2142). As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Specifically, a person of ordinary skill in the art would, based upon the symbols used in FIG. 1 of Bretschneider, understand the elements 40 and 42 in FIG. 1 of Bretschneider to be a keyboard and a mouse, respectively. Furthermore, one skilled in the art would consider a mouse to be a pointing device since the function of a mouse is to control a cursor to point to objects for selection by a "mouse click." Therefore, if the pointing device 42 in FIG. 1 of Bretschneider is taken to be the presently claimed apparatus, then Bretschneider does not disclose a mouse. If the pointing device 42 in FIG. 1 of Bretschneider is taken to be the mouse, then Bretschneider does not disclose an apparatus as presently claimed. Therefore, the Office Action fails to meet the Office's burden of factually establish a *prima facie* case of obviousness by showing that Bretschneider and Sartore, alone or in combination, teach or suggest all the claim limitations of the presently claimed invention (MPEP §2142). As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Furthermore, with respect to claim 20, the Office Action fails to fully apply the cited references to the specific claim limitations. Specifically, the Office Action does not address how the combination of Bretschneider and Meyn meet the claim limitation of "a device **consisting of** (a) a housing configured to be held in a hand of a presenter, (b) a first button and a second button disposed in a surface of said housing and (c) a control circuit (i) disposed within said housing and (ii) configured to generate one or more first control signals when said first button is pressed and one or more second control signals when said second button is pressed, wherein (i) said one or more first control signals and said one or more second control signals are dedicated to controlling advancement through a plurality of slides presented by an electronic presentation program and (ii) said control circuit is configured to communicate through a bus with a standard device driver provided in an operating system," as presently claimed (see page 8, section 8 of the Office Action). The reference in the Office Action to the discussion of Bretschneider with respect to claims 1, 4, 5, 7-9, 12, 15-17, 19, 21-23 and 27 does not adequately address the claim limitations of claim 20 because claims 1 and 16 do not include the transitional phrase "consisting of," which excludes any element not listed in the claim (see MPEP §2111.03).

In particular, the mouse 42 of Bretschneider is referred to as a pointing device (column 4, lines 44-46 Bretschneider). One skilled in the art would understand that a mouse or pointing device would necessarily include mechanical or optical elements for generating signals in response to the motion of the mouse 42. The signals generated in response to the motion of the mouse 42 of Bretschneider would control a cursor of the personal computer 20 of Bretschneider. Therefore, Bretschneider does not appear to teach or suggest a device **consisting of** (a) a housing configured to be held in a hand of a presenter, (b) a first button and a second button disposed in a surface of said housing and (c) a control circuit (i) disposed within said housing and (ii) configured to generate one or more first control signals when said first button is pressed and one or more second control signals when said second button is pressed, as presently claimed.

Meyn does not cure the deficiencies of Bretschneider. The device in FIG. 3 of Meyn clearly includes numerous keys and a mouse disk. In particular, Meyn discloses a mouse control device (FIG. 3 and column 2, lines 55-56 of Meyn). Meyn states:

Navigating and entering commands, with the remote control device may be accomplished with relatively few keys. The mouse disk and the Forward/Reverse keys. To select a button, checkbox, list box, or any item in a list box, the mouse disc is rotated to highlight the item. Once in a list box, Forward and Reverse are pressed to select an item. To click a button or check a checkbox (once selected),

the mouse disc is pressed. (column 13, lines 51-56 of Meyn, emphasis added).

Since (i) the mouse control device of Meyn includes the mouse disk and numerous keys and (ii) the mouse disk and the Forward and Reverse keys of Meyn are used for "navigating and entering commands" and to select items in a list box, it follows that Meyn does not teach or suggest a device **consisting of** (a) a housing configured to be held in a hand of a presenter, (b) a first button and a second button disposed in a surface of the housing and (c) a control circuit (i) disposed within the housing and (ii) configured to generate one or more first control signals when the first button is pressed and one or more second control signals when the second button is pressed, where (i) the one or more first control signals and the one or more second control signals are **dedicated to controlling advancement through a plurality of slides** presented by an electronic presentation program, as presently claimed. Therefore, the Office Action fails to meet the Office's burden of factually establish a *prima facie* case of obviousness by showing that Bretschneider and Meyn, alone or in combination, teach or suggest all the claim limitations of the presently claimed invention (MPEP §2142). As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Claims 2-5, 7-15, 17 and 19-27 depend, either directly or indirectly, from claims 1 or 16 which are believed to be allowable.

As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

New claims 28-33 depend directly from either claim 1 or claim 16 which are believed to be allowable. As such, claims 28-34 are fully patentable over the cited references.

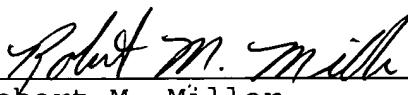
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicants' representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

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